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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,637	11/18/2003	Jonathan D. Cooper	JDC-002-US	7673

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CAPSTONE LAW GROUP LLP
1810 GATEWAY DRIVE
SUITE 260
SAN MATEO, CA 94404

EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,637

Applicant(s)

COOPER, JONATHAN D.

Examiner

John W Hayes

Art Unit

3621

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Applicant has amended claims 59-62, 64-65, 67-68 and 71-74 in the amendment filed 25 August 2004. Thus, claims 59-75 are the only claims pending.

Response to Arguments

2. Applicant's arguments with respect to claims 59-75 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 59, 61, 68-79, 72-73 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al, U.S. Patent No. 5,963,647 in view of Picciallo, U.S. Patent No. 6,044,360.

As per **Claims 59, 61 and 73**, Downing et al disclose an automated process for sending money from a first location to a second location comprising:

- receiving a request for a secure money transfer from a requestor (Col. 6, lines 18-30);
- receiving information associated with a recipient for said secure money transfer (Col. 6, lines 18-30);
- receiving information indicating an amount of said secure money transfer (Col. 6, lines 18-30);

Art Unit: 3621

- assigning an authorization to the secure money transfer for using the secure money transfer instrument in automated teller machines wherein the authorization includes an access code in order to receive money at the ATM (Col. 6, lines 20-30; Col. 7, lines 18-28; Col. 12, lines 10-45);
- providing said access code from said requestor to said recipient (Col. 7, lines 6-18);
- whereby said access code enable said recipient to withdraw funds using automated teller machines (Col. 4, lines 35-50; Col. 6, lines 20-30; Col. 7, lines 18-28; Col. 12, lines 10-45).

Downing, however, fails to explicitly disclose the use of a standard atm card configured to enable the completion of the secure money transfer and wherein the computer readable medium is delivered to the recipient consumer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds from a sender to a recipient and further teaches that a computer readable medium such as an atm card is configured to enable the completion of the secure money transfer using atm machines (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium such as a standard atm card to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient, thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

As per **Claims 68 and 72**, Downing et al disclose an automatic money transfer system for transferring money from a donor to a donee comprising:

- an automated server system for facilitating the secure transfer of money from a donor to a donee, and to assign a security code to said transfer (Col. 6, lines 18-30);

Art Unit: 3621

- a data storage device for recording said secure transfer (Col. 5, lines 60-65; Col. 6, lines 50-65; Col. 8 line 35-Col. 9 line 20); and

- enabling the donee to access the funds from an ATM using the security code (Col. 7, lines 18-28; Col. 12, lines 10-45).

- wherein said donor provides the security code to the donee (Col. 7, lines 6-18).

Downing, however, fails to explicitly disclose the use of a standard atm card configured to enable the completion of the secure money transfer and wherein the computer readable medium is delivered to the recipient consumer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds from a sender to a recipient and further teaches that a computer readable medium such as an atm card is configured to include machine readable information and enable the completion of the secure money transfer using atm machines (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium such as a standard atm card to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient, thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

As per **Claim 69**, Downing et al fail to disclose wherein the security code is contained in the machine readable information. Examiner takes Official Notice, however, that storing a security code in machine readable information on a standard ATM card is notoriously well known in the art. Security codes such as PINs are typically encoded on the magnetic stripe of standard ATM cards and it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use the

Art Unit: 3621

magnetic stripe to store a security code in order to ensure that the card is not being used by an unauthorized user.

As per Claim 70, Downing et al further disclose wherein the security code must be manually entered on the atm by the donee in order for the donee to receive money (Col. 7, lines 29-45).

As per Claim 75, Downing et al further disclose wherein the access code is provided to the recipient by the sender (Col. 7, lines 6-18).

5. Claims 60, 71 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al, U.S. Patent No. 5,963,647 and Picciallo, U.S. Patent No. 6,044,360 as applied above and further in view of Ito et al, U.S. Patent No. 6,039,250.

As per Claims 60, 71 and 74, Downing et al and Picciallo fail to disclose determining whether the recipient receives the secure money transfer instrument and providing a credit to the sender if not. Ito et al disclose an electronic money sending system and teaches that the sender receives a refund in the amount of the requested transfer in the case where the recipient does not receive the funds (Col. 2, lines 34-47; Col. 5 line 65-Col. 6 line 5; Col. 7, lines 38-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brody et al and provide a means for crediting or refunding the transfer amount back to the sender as taught by Ito et al in case the card or funds are not actually received by the recipient. The motivation for this was well known at the time of applicant's invention. For example, if the card or funds cannot be delivered to the recipient, then they would naturally be returned to the sender to avoid the loss of money to the sender.

6. Claims 62-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al, U.S. Patent No. 5,963,647 and Picciallo, U.S. Patent No. 6,044,360 as applied above and further in view of Corder et al, U.S. Patent No. 5,936,221.

As per **Claims 62-63**, Downing et al further disclose wherein the secure money transfer is used to transfer money from the requestor located in a first country to a recipient located in a second country using different currencies from different nationalities (Col. 3, lines 60-65; Col. 6, lines 25-47). Downing et al, however, fail to disclose that the requestor may allocate additional money to the secure money transfer instrument via a communications network. Corder et al disclose a system and method for transferring value to a card and further disclose that additional funds may be added and transferred to the card via a communications network (Col. 2, lines 20-39). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing et al and include the ability to add additional funds to the secure money transfer to provide a convenient method for the recipient to have access to additional funds when the original transfer amount is depleted.

As per **Claims 64-66**, Downing et al disclose an automated process for sending money from a first location to a second location comprising:

- receiving a request for a secure money transfer from a requestor indicating a destination for said transfer and an amount for transfer via a communications network (Col. 6, lines 18-30);
- assigning an authorization to the secure money transfer for using the secure money transfer instrument in automated teller machines wherein the authorization includes an access code in order to receive money at the ATM (Col. 6, lines 20-30; Col. 7, lines 18-28; Col. 12, lines 10-45);
- providing said access code from said requestor to said recipient (Col. 7, lines 6-18);
- whereby said access code enables said recipient to withdraw funds using automated teller machines (Col. 4, lines 35-50; Col. 6, lines 20-30; Col. 7, lines 18-28; Col. 12, lines 10-45).

Downing, however, fails to explicitly disclose the use of a standard atm card configured to enable the completion of the secure money transfer and wherein the standard atm card is delivered to the recipient consumer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds from a sender to a recipient and further teaches that a computer readable medium such as an atm card is configured to enable the completion of the secure money transfer using

Art Unit: 3621

atm machines (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium such as a standard atm card to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient, thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

Downing et al further fail to explicitly disclose that the requestor submit additional requests for allocating additional money to the atm card via a communications network. Corder et al disclose a system and method for transferring value to a card and further disclose that additional funds may be added and transferred to the card via a communications network (Col. 2, lines 20-39). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brody et al and include the ability to add additional funds to the secure money transfer to provide a convenient method for the recipient to have access to additional funds when the original transfer amount is depleted.

7. Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al, U.S. Patent No. 5,963,647 in view of Picciallo, U.S. Patent No. 6,044,360 and Corder et al, U.S. Patent No. 5,936,221 as applied above and further in view of Ito et al, U.S. Patent No. 6,039,250.

As per Claim 67, Downing et al, Picciallo and Corder et al et al fail to disclose determining whether the recipient receives the secure money transfer instrument and providing a credit to the sender if not. Ito et al disclose an electronic money sending system and teaches that the sender receives a refund in the amount of the requested transfer in the case where the recipient does not receive the funds

Art Unit: 3621

(Col. 2, lines 34-47; Col. 5 line 65-Col. 6 line 5; Col. 7, lines 38-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing et al, Picciallo and Corder et al and provide a means for crediting or refunding the transfer amount back to the sender as taught by Ito et al in case the card or funds are not actually received by the recipient. The motivation for this were well known at the time of applicant's invention. For example, if the card or funds cannot be delivered to the recipient, then they would naturally be returned to the sender to avoid the loss of money to the sender.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

10. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Marcous et al discloses many features of applicant's invention, however, without the need to have a card to activate the dispensing terminal
- Stoutenburg et al disclose a method for performing money transfers through a TCP/IP network including establishing a desired amount to be transferred, establishing a code that corresponds to the transaction details and transmitting the code from the sender to the recipient
- Rizzo et al disclose a method for cash transfers that allows an originator to set up a transaction using a telephone or website and transfer money to a recipient who uses an ATM card to receive the funds
- Downing et al disclose a method for transferring funds from an account to an individual and teach that an originator can transfer an amount to a cash access file which can be accessed 24 hours a day wherein access is achieved by the recipient entering a codeword selected by the sender along with a transaction code and wherein the recipient can receive funds through an ATM even without using a card to access the system.
- Ito et al disclose a method of transferring funds from a sender to a receiver using a communications network and e-mail.
- Farris et al disclose a method for transferring funds from a customer to a patron by depositing cash into a kiosk, providing a security code to the customer who then provides this code to a patron who inputs the code into a kiosk in order to receive the funds.
- Cucinotta et al disclose a method for holding and dispensing cash upon demand at a remote location
- Jennings et al disclose a method for transferring funds by allowing funds to be transferred instantly to an account so that they are available to a beneficiary
- Davis et al disclose a method for activating cards at the point of distribution.

Art Unit: 3621

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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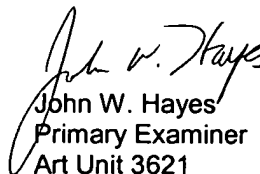
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,
VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

November 4, 2004